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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,485	10/27/2003	Toshihiko Uno	117571	3123
25944	7590	12/01/2005		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER MILLER, CHERYL L	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/693,485	UNO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cheryl Miller	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/27/03</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Positive recitation of a portion of the body is considered non-statutory subject matter.

Claims 1 and 7 each recite in line 1, “lens which is placed between an iris”. It is suggested to change the above language to recite a lens which is for placement between, or a lens which is capable of being placed, or a lens which is adapted for placement between, etc.

Claims 1 and 7 also each recite in line 8 and 10 respectively, “support part which holds the optical part in the eye”. It is suggested to change the above language to recite support part adapted to hold the optical part in the eye, or similar intended use language. Claims 2-6 and 8-9 depend upon claims 1 and 7 and inherit all problems associated with the claims.

Claims 4, 6, 8, and 9 each recite, “portion which makes contact with the crystalline lens”. It is suggested to change the above to recite, portion which is adapted to make contact with the crystalline lens, or similar functional language.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Shepard (US 4,994,080). Shepard discloses an IOL (capable of placement between the lens and

Art Unit: 3738

iris (fig.13) comprising an optic part (20) with power, large in diameter (fig.13), and having a pore (22, 28, 30) formed in a region of the optic part, and a support (48, 50) that is capable of holding the optic in the eye. Shepard discloses a pore to have a diameter of between  $0.01\mu$  and 1 mm (col.5, lines 32-36; col.9, lines 57-61), sized to allow aqueous fluid to pass through the lens (the size disclosed by Shepard is within the range disclosed by the applicant, therefore, Shepard's pore will inherently provide the same function). Shepard discloses at least one protrusion (ridge) adapted to contact the crystalline lens (col.11, lines 56-64).

Claims 1, 2, 4, 5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Feingold (US 5,913,898). Feingold discloses an IOL (fig.20-26) capable of placement between the lens and iris (fig.25, 26) comprising an optic part (74, 84) with power, large in diameter (see figs), and having a pore (86; fig.22, 23) formed in a region of the optic part, and a support (72, 82) that is capable of holding the optic in the eye. Feingold discloses a pore (86) sized to allow aqueous fluid to pass through the lens (col.1, lines 57-61). Feingold discloses the optic or support to have a groove (groove disclosed to be on anterior or posterior surface; col.2, lines 18-55) adapted to contact the crystalline lens, which allows fluid to flow toward the pore.

Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Peyman et al. (US 6,280,471 B1). Peyman discloses an IOL (440; figs.41-66) capable of placement between the lens and iris (col.11, lines 33-53) comprising an optic part (444) with power, large in diameter, and having a pore (442, 443; col.13, lines 47-65) formed in a region of the optic part, and a support (302) that is capable of holding the optic in the eye. Peyman discloses a pore (442,

Art Unit: 3738

443) to have a diameter of between  $0.01\mu$  and 1 mm (opening 204 is disclosed to be between 0.5 and 3mm, in fig.11, and the openings 442 are smaller than the opening in fig.11, and since they are disclosed to pass aqueous fluid, inherently they are within this range), sized to allow aqueous fluid to pass through the lens (col.2, lines 45-50).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Miller



**CORRINE McDERMOTT**  
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